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NO. 7922 P. 1/7

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<b>FAX TRANSMISSION</b>		<b>MS PCT</b>
DATE: <i>September 14, 2005</i>		
PTO IDENTIFIER: Application Number 10/525468 ✓ Patent Number		
Inventor: Thomas Genger et al.		
MESSAGE TO: US Patent and Trademark Office		
FAX NUMBER: (571) 273-8300		
FROM: CONNOLLY BOVE LODGE & HUTZ LLP Ashley I. Pezzner		
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Attorney Dkt. #: 12810-00027-US		
PAGES (Including Cover Sheet): <u>7</u>		
CONTENTS:	Transmittal Of Translation Of International Preliminary Examination Report Translation Of International Preliminary Examination Report Certificate of Transmission	
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Application No. (if known): 10/525468

Attorney Docket No.: 12810-00027-US

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Transmittal Of Translation Of International Preliminary Examination Report

Translation Of International Preliminary Examination Report

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NO. 7922 P. 3/7

Application No.: 10/525468

Docket No.: 12810-00027-US

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:  
Thomas Genger et al.

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Application No.: 10/525468

**SEP 14 2005** Confirmation No.: @@@

Filed: February 24, 2005

Art Unit: N/A

For: OXIDATION PROCESS

Examiner: Not Yet Assigned

**TRANSMITTAL OF TRANSLATION OF INTERNATIONAL PRELIMINARY  
EXAMINATION REPORT**

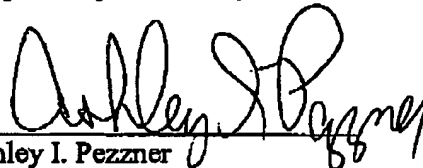
MS PCT  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Applicant submits herewith a translation of the International Preliminary Examination Report ("IPER") issued in the corresponding international application. The reference cited in the IPER was cited in an Information Disclosure Statement filed by Applicant. The International Bureau of WIPO has deemed that claims 1-14 have novelty and industrial applicability.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 03-2775, under Order No. 12810-00027-US from which the undersigned is authorized to draw.

Respectfully submitted,

By   
Ashley I. Pezzner

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## PATENT COOPERATION TREATY

PCT/EP2003/008407



## PCT

## INTERNATIONAL PRELIMINARY EXAMINATION REPORT

(PCT Article 36 and Rule 70)

Applicant's or agent's file reference 0000053889	<b>FOR FURTHER ACTION</b> See Notification of Transmittal of International Preliminary Examination Report (Form PCT/IPBA/416)	
International application No. PCT/EP2003/008407	International filing date (day/month/year) 30 July 2003 (30.07.2003)	Priority date (day/month/year) 30 August 2002 (30.08.2002)
International Patent Classification (IPC) or national classification and IPC B01J 19/00		
Applicant BASF AKTIENGESELLSCHAFT		

1. This international preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.

2. This REPORT consists of a total of 4 sheets, including this cover sheet.

☐ This report is also accompanied by ANNEXES, i.e., sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications made before this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions under the PCT).

These annexes consist of a total of        sheets.

3. This report contains indications relating to the following items:

- I ☒ Basis of the report
- II ☐ Priority
- III ☐ Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- IV ☐ Lack of unity of invention
- V ☒ Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- VI ☐ Certain documents cited
- VII ☐ Certain defects in the international application
- VIII ☐ Certain observations on the international application

Date of submission of the demand 09 December 2003 (09.12.2003)	Date of completion of this report 03 August 2004 (03.08.2004)
Name and mailing address of the IPBA/EP	Authorized officer
Facsimile No.	Telephone No.

Form PCT/IPBA/409 (cover sheet) (July 1998)

## INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.

PCT/EP2003/008407

## I. Basis of the report

## 1. With regard to the elements of the international application:\*

- ☐ the international application as originally filed
- ☒ the description:  
 pages 1-12, as originally filed  
 pages \_\_\_\_\_, filed with the demand  
 pages \_\_\_\_\_, filed with the letter of \_\_\_\_\_
- ☒ the claims:  
 pages 1-14, as originally filed  
 pages \_\_\_\_\_, as amended (together with any statement under Article 19  
 pages \_\_\_\_\_, filed with the demand  
 pages \_\_\_\_\_, filed with the letter of \_\_\_\_\_
- ☐ the drawings:  
 pages \_\_\_\_\_, as originally filed  
 pages \_\_\_\_\_, filed with the demand  
 pages \_\_\_\_\_, filed with the letter of \_\_\_\_\_
- ☐ the sequence listing part of the description:  
 pages \_\_\_\_\_, as originally filed  
 pages \_\_\_\_\_, filed with the demand  
 pages \_\_\_\_\_, filed with the letter of \_\_\_\_\_

## 2. With regard to the language, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.

These elements were available or furnished to this Authority in the following language \_\_\_\_\_ which is:

- ☐ the language of a translation furnished for the purposes of international search (under Rule 23.1(b)).
- ☐ the language of publication of the international application (under Rule 48.3(b)).
- ☐ the language of the translation furnished for the purposes of international preliminary examination (under Rule 55.2 and/or 55.3).

## 3. With regard to any nucleotide and/or amino acid sequence disclosed in the international application, the international preliminary examination was carried out on the basis of the sequence listing:

- ☐ contained in the international application in written form.
- ☐ filed together with the international application in computer readable form.
- ☐ furnished subsequently to this Authority in written form.
- ☐ furnished subsequently to this Authority in computer readable form.
- ☐ The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.
- ☐ The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

4. ☐ The amendments have resulted in the cancellation of:

- ☐ the description, pages \_\_\_\_\_
- ☐ the claims, Nos. \_\_\_\_\_
- ☐ the drawings, sheets/fig \_\_\_\_\_

5. ☐ This report has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(e)).\*\*

\* Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report since they do not contain amendments (Rule 70.16 and 70.17).

\*\* Any replacement sheet containing such amendments must be referred to under item 1 and annexed to this report.

## INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.

PCT/EP 03/08407

## V. Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

## 1. Statement

Novelty (N)	Claims	1-14	YES
	Claims		NO
Inventive step (IS)	Claims		YES
	Claims	1-14	NO
Industrial applicability (IA)	Claims	1-14	YES
	Claims		NO

## 2. Citations and explanations

## 1. PRIOR ART AND NOVELTY

The claimed subject matter of independent claim 1 is novel under PCT Article 33(2). Document EP-A-0 842 894 (D1), which represents the closest prior art, describes a method of oxidizing a gaseous hydrocarbon with oxygen. All the features of the claimed subject matter except the boiling state are described in D1 (cf. figure on page 4 with at least two oxygen flows as well as the description in column 1, line 55 to column 2, line 20 of the cylindrical reactor and claims 1 to 7). The claimed subject matter therefore differs from the subject of claim 1 only in that the reaction mixture is in the boiling state (gas and liquid phase present simultaneously) rather than in the gas-phase state.

## 2. INVENTIVE STEP

The application as originally filed does not contain a comparative example reflecting the closest prior art (D1). It is therefore uncertain whether a technical problem is actually solved as a result of the distinguishing feature (boiling state instead of gaseous state).

The IPEA cannot see that what is described on page 2, lines 31-35 of the application as the problem to be solved

Form PCT/IPEA/409 (Box V) (January 1994)

## INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.

PCT/EP 03/08407

is relevant to D1: both reacting substances (hydrocarbon and oxidant) are in the gaseous state in the method in D1. The reaction mixture therefore does not have the disadvantages that are cited in the application (page 2, lines 31-45) as disadvantages of the prior art.

Without proof of solving a technical problem through the distinguishing technical feature, an inventive step in the claimed subject matter cannot be recognized.

Distinguishing technical features that do not contribute to solving a technical problem cannot be considered inventive, as they are to be seen as obvious changes to the prior art. Arguments concerning the "non-obviousness" of the claimed subject matter therefore do not help in assessing inventive step.